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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,780	08/14/2001	Koichi Kawana	450100-03413	9015
20999 7590 01/28/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER VAN HANDEL, MICHAEL P	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 01/28/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/929,780

Applicant(s)

KAWANA ET AL.

Examiner

Michael Van Handel

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-12 and 14-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

### ***Response to Amendment***

1. This action is responsive to an Amendment filed 10/31/2007. Claims **1-4, 6-12, 14-18** are pending. Claims **1, 9, 17, 18** are amended. Claims **5, 13** are canceled.

### ***Response to Arguments***

1. Applicant's arguments regarding claims **1, 9, 17, and 18**, filed 10/31/2007, have been fully considered, but they are not persuasive.

Regarding claims **1, 9, 17, and 18**, the applicant argues that neither Ellis et al. nor Gaucher teaches or suggests a determination means for determining whether the selection information indicates information that has been recorded previously by one of the plurality of electronic apparatuses and determining which one of the plurality of apparatuses the information is recorded on. The examiner respectfully disagrees. Ellis et al. discloses allowing a user to remotely access video and audio stored on a secondary storage device 32 at user television

equipment 22 (p. 12, paragraph 133). Ellis et al. further discloses that, if there are multiple installations of user television equipment 22 within the home connected via an in-home network, the remote program guide access device 24 may be connected via remote access link 19 to one of the guides and may provide users with the ability to remotely coordinate functions of all of the guides (p. 6, 7, paragraph 87). Ellis et al. also discloses that remote program guide access device 24 allows a user to interact with peripherals connected to user television equipment (p. 9, paragraph 107). The remote program guide access device may query the local interactive television program guide for media directory information stored on digital storage device 31 or secondary storage device 32. The remote program guide access device may then remotely play a stored program on a remote program guide access device (p. 2, paragraph 15; p. 12, paragraphs 133, 134; p. 16, paragraphs 168-170; & Figs. 11, 21). Since Ellis et al. discloses providing media directory information for selecting a program from storage device 31 or secondary storage device 32 for remote playing, the examiner maintains that Ellis et al. meets the limitation of “determination means for determining whether the selection information indicates information that has been recorded previously by one of the plurality of electronic apparatuses and determining which one of the plurality of apparatuses the information is recorded on,” as currently claimed.

Further regarding claims 1, 9, 17, and 18, the applicant argues that neither Ellis et al. nor Gaucher teaches or suggests designating a point for which to begin playback as a function of the selection information when the determination means determines the information has been recorded previously and determines which one of the apparatuses the information is recorded on. The examiner respectfully disagrees. Ellis et al. discloses that, in response to user selection of a

directory entry on the remote access program guide, an appropriate access communication is issued to the interactive television program guide to play back the selection and transmit it back to remote program guide access device 24 over remote access link 19. Remote program guide access device 24 may play the video for the user (p. 12, paragraph 134). Since the program selection is played back in response to an appropriate access communication, the examiner notes that it is inherent that a point be designated from which to begin playback as a function of the selection information. As such, the examiner maintains that Ellis et al. meets the limitation of “designating a point for which to begin playback as a function of the selection information when the determination means determines the information has been recorded previously and determines which one of the apparatuses the information is recorded on,” as currently claimed.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-4, 6-12, 14-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Referring to claims 1, 17, and 18, the examiner fails to find support for the amended claims. The language of the amended limitations of the claims is confusing in light of

Applicant's specification and does not appear to correspond with the specification in such a way as to reasonably convey possession of the claimed invention. For example, the examiner interprets the "program recording and playing apparatus" of Applicant's claims to be the home server, as indicated by "[t]he home server 100 includes a program management unit for managing the database that stores program information for broadcast programs" in Applicant's specification (see p. 1, paragraph 10 & p. 2, paragraph 37 of published application US 2002/0023266). The examiner interprets the "one of a plurality of electronic apparatuses" that the "transmission means" transmits "program information" to using "wireless communication" of the claims as being the portable terminal, as indicated by "a transmission unit for transmitting the program information stored in the database to an electronic apparatus using wireless communication" and "[t]he electronic apparatus may include a portable terminal" in the specification (p. 1, paragraphs 10 & 11). The examiner notes that Applicant's specification refers to the HDD 302 and VCR 303 as "home appliances" that "are connected to the home server 100 by a daisy-chain or a bus" (p. 3, paragraph 47 & Figs. 1, 5, 7B). That is, Applicant's specification does not indicate that the home appliances utilize wireless communication.

Applicant's specification further indicates that "an apparatus having functions of recording and playing broadcast programs" is controlled "under the control of the electronic apparatus," wherein the "apparatus having functions of recording and playing broadcast programs may include an audio apparatus or a video apparatus" (p. 1, paragraphs 10, 13). In light of these passages and the examiner's interpretation of the "one of a plurality of electronic apparatuses" as being the portable terminal, the claimed limitations "wherein *each* of the plurality of electronic apparatuses function to record and play programs (*italicized for*

emphasis)” and “control means for controlling *each* of the plurality of electronic apparatuses recording and playing function in accordance with received selection information (italicized for emphasis)” do not make sense. This would indicate that the portable terminal functions to record and play programs and further that the portable terminal controls itself to record and play these programs through wireless communication with the home server. The examiner further notes that Applicant’s specification indicates that the portable terminal receives and stores program information, but never indicates that the portable terminal receives or stores the program itself. The home server controls the TV to display the images from the VCR or HDD (p. 5, paragraph 62 & Figs. 6, 7). As such, the examiner fails to find support for the amended claims in Applicant’s specification. Should the applicant maintain support for the claimed invention, the examiner requests clarification, describing each of the elements in the specification that correspond to each of the claimed elements.

Similarly with respect to claim 9, the language of the amended claim limitations is confusing in light of Applicant’s specification and does not appear to correspond with the specification in such a way as to reasonably convey possession of the claimed invention. As noted above, the examiner interprets the “one of a plurality of electronic apparatuses” that the “transmission means” transmits “program information” to using “wireless communication” of the claims as being the portable terminal, as indicated by “a transmission unit for transmitting the program information stored in the database to an electronic apparatus using wireless communication” and “[t]he electronic apparatus may include a portable terminal” in the specification (p. 1, paragraphs 10 & 11). Furthermore, the claimed limitations “wherein *each* of the plurality of electronic apparatuses function to record and play programs (italicized for

emphasis)” and “a command that controls *each* of the plurality of electronic apparatuses recording and playing functions (italicized for emphasis)” do not make sense. This would indicate that the portable terminal functions to record and play programs and further that the portable terminal controls itself to record and play these programs through wireless communication with the home server. The examiner further notes that Applicant’s specification indicates that the portable terminal receives and stores program information, but never indicates that the portable terminal receives or stores the program itself. The home server controls the TV to display the images from the VCR or HDD (p. 5, paragraph 62 & Figs. 6, 7).

Applicant’s specification also indicates that “the home server 100 determines whether the selected information indicates an already recorded broadcast program” (p. 5, paragraph 61), whereas the claimed invention indicates that the “portable terminal” comprises the “determination means for determining whether the selected information indicates information that has been recorded previously.” As such, the examiner fails to find support for the amended claim in Applicant’s specification. Should the applicant maintain support for the claimed invention, the examiner requests clarification, describing each of the elements in the specification that correspond to each of the claimed elements.

Claims **2-4, 6-8, 9-12**, and **14-16** are rejected as being dependent on the rejected independent claims.

### ***Claim Objections***

1. Claims **2-4, 10-12** are objected to because of the following informalities:



Referring to claim **2**, the examiner notes that the phrase “said electronic apparatus” lacks antecedent basis. Claim 1 refers to “one of a plurality of electronic apparatuses” in two different places and refers to “each of the plurality of electronic apparatuses,” but never refers to an electronic apparatus. The examiner recommends that the phrase be changed to “an electronic apparatus” and addresses the claim in the Office Action below as though the recommended changes have been made.

Claim **3** is objected to as being dependent on claim 2.

Referring to claim **4**, the examiner notes that the phrase “the apparatus having functions of recording and playing programs” lacks antecedent basis. Claim 1 refers to “each of the plurality of electronic apparatuses function to record and play programs,” but never refers to an apparatus having functions of recording and playing programs. The examiner recommends that the phrase be changed to “an apparatus having functions of recording and playing programs” and addresses the claim in the Office Action below as though the recommended changes have been made.

Referring to claim **10**, the examiner notes that the phrase “the electronic apparatus” lacks antecedent basis. Claim 9 refers to “one of a plurality of electronic apparatuses” in two different places and refers to “each of the plurality of electronic apparatuses,” but never refers to an electronic apparatus. The examiner recommends that the phrase be changed to “an electronic apparatus” and addresses the claim in the Office Action below as though the recommended changes have been made.

Claim **11** is objected to as being dependent on claim 10.

Referring to claim 12, the examiner notes that the phrase “the apparatus having functions of recording and playing programs” lacks antecedent basis. Claim 9 refers to “each of the plurality of electronic apparatuses function to record and play programs,” but never refers to an apparatus having functions of recording and playing programs. The examiner recommends that the phrase be changed to “an apparatus having functions of recording and playing programs” and addresses the claim in the Office Action below as though the recommended changes have been made.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 8-12, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. in view of Gaucher.

Referring to claims 1, 2, 4, 6, and 17, Ellis et al. discloses a program recording and playing apparatus/method, comprising:

- program management means for managing a database that stores program information for programs (p. 4, 5, paragraphs 69, 70);
- transmission means for transmitting the program information stored in the database to one of a plurality of electronic apparatuses using wireless communication (p. 5,

paragraphs 71, 74; p. 6, paragraph 86; & Figs. 3, 4), wherein each of the plurality of electronic apparatuses function to record and play programs (p. 2, paragraph 15; p. 6, paragraphs 81, 83-85; & p. 7, paragraph 91);

- control means for controlling each of the plurality of electronic apparatuses recording and playing function in accordance with received selection information (p. 2, paragraph 15; p. 11, paragraph 127; & p. 12, paragraphs 133, 134); and
- determination means for determining whether the selection information indicates information that has been recorded previously by one of the plurality of electronic apparatuses and determining which one of the plurality of apparatuses the information is recorded on (p. 6, paragraph 87; p. 9, paragraphs 107, 110; p. 12, paragraphs 133, 134; p. 16, paragraphs 168-170; p. 21, paragraph 220; & Figs. 11, 21), and for designating a point for which to begin playback as a function of the selection information when the determination means determines the information has been recorded previously and determines which one of the apparatuses the information is recorded on (the examiner notes that the user can select a stored program for playback using remote program guide access device 24. The remote program guide access device 24 issues an appropriate access communication to the interactive television program guide to play back the selection and to transmit it to remote program guide access device over remote access link 19)(p. 2, paragraph 15; p. 12, paragraphs 133, 134; p. 16, paragraphs 168-170; & Figs. 11, 21), wherein the apparatus prepares for playing in accordance with the designation and transmits an acknowledgement 2240,

and wherein when the acknowledgement is confirmed 2250, playback is ready to begin (p. 2, paragraph 133 & Figs. 3, 4, 21).

Ellis et al. further discloses that the remote access link 19 is a wireless cellular link or an infrared link (p. 5, paragraph 77; p. 6, paragraph 86; & p. 7, paragraphs 90, 93, 94). Ellis et al. still further discloses that the remote program guide access device 24 is a personal digital assistant (PDA)(p. 7, paragraph 92). Ellis et al. does not disclose a switching means for switching a wireless communication unit between communication using a public circuit based on a spread spectrum communication system and short-distance wireless communication based on the spread spectrum communication system. Gaucher discloses a local wireless network (col. 2, l. 34-36). A cellular phone PDA device controls a VCR to record a particular program through a master computer of the local wireless network if within a specific range. If out of range, the PDA device accesses the master computer and VCR through a cellular modem (col. 3, l. 32-43 & col. 6, l. 34-47, 60-63). The PDA communicates with the master computer and VCR through high power spread spectrum communications (col. 3, l. 60-61; col. 6, l. 1-17; & col. 10, l. 38-46). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the communication between the remote program access device and local interactive television program guide of Ellis et al. to include switching between a cellular network and a local spread spectrum network depending on a remote access device's location, such as that taught by Gaucher in order to provide a more cost-efficient device.

Referring to claims 3 and 11, the combination of Ellis et al. and Gaucher teaches a program recording and playing apparatus/portable terminal according to claims 2 and 10, respectively, wherein said portable terminal comprises a private apparatus (Since the remote

program access device 24 communicates with a particular user's set-top box (see citations noted with respect to claim 1), the examiner interprets the remote program access device to be a private apparatus).

Referring to claims 8 and 16, the combination of Ellis et al. and Gaucher teaches a program recording and playing apparatus/portable terminal according to claims 6 and 14, respectively, wherein the short-distance wireless communication is based on an infrared data communication system (Ellis et al. p. 6, paragraph 86 & p. 7, paragraphs 90, 93).

Referring to claims 9, 10, 12, 14, and 18, Ellis et al. discloses a portable terminal/method for recording and playing programs, comprising:

- transmission means for transmitting program information stored in a database that stores the program information for programs to one of a plurality of electronic apparatuses using wireless communication (p. 5, paragraphs 71, 74; p. 6, paragraph 86; & Figs. 3, 4), wherein each of the plurality of electronic apparatuses function to record and play programs (p. 2, paragraph 15; p. 6, paragraphs 81, 83-85; & p. 7, paragraph 91);
- display means for displaying the program information obtained using said transmission means (p. 7, paragraph 92; p. 8, paragraph 102; & Fig. 5);
- command transmission means for transmitting a command that controls each of the plurality of electronic apparatuses recording and playing functions to a server that controls recording and playing performed by the electronic apparatuses (p. 2, paragraph 15; p. 6, paragraph 86; p. 11, paragraph 127; & p. 12, paragraphs 133, 134); and

- determination means for determining whether the command indicates information that has been recorded previously by one of the plurality of electronic apparatuses and determining which one of the plurality of electronic apparatuses the information is recorded on (p. 6, paragraph 87; p. 9, paragraphs 107, 110; p. 12, paragraphs 133, 134; p. 16, paragraphs 168-170; p. 21, paragraph 220; & Figs. 11, 21), and for designating a point for which to begin playback as a function of the command when the determination means determines the information has been recorded previously and determines which one of the electronic apparatuses the information is recorded on (the examiner notes that the user can select a stored program for playback using remote program guide access device 24. The remote program guide access device 24 issues an appropriate access communication to the interactive television program guide to play back the selection and to transmit it to remote program guide access device over remote access link 19)(p. 2, paragraph 15; p. 12, paragraphs 133, 134; & p. 16, paragraphs 168-170), wherein the determined electronic apparatus prepares for playing in accordance with the designation and transmits an acknowledgement 2240, and wherein, when the acknowledgement is confirmed 2250, playback is ready to begin (p. 2, paragraph 133 & Figs. 3, 4, 21).

Ellis et al. further discloses that the remote access link 19 is a wireless cellular link or an infrared link (p. 5, paragraph 77; p. 6, paragraph 86; & p. 7, paragraphs 90, 93, 94). Ellis et al. still further discloses that the remote program guide access device 24 is a personal digital assistant (PDA)(p. 7, paragraph 92). Ellis et al. does not disclose a switching means for switching a wireless communication unit between communication using a public circuit based on a spread

spectrum communication system and short-distance wireless communication based on the spread spectrum communication system. Gaucher discloses a local wireless network (col. 2, l. 34-36). A cellular phone PDA device controls a VCR to record a particular program through a master computer of the local wireless network if within a specific range. If out of range, the PDA device accesses the master computer and VCR through a cellular modem (col. 3, l. 32-43 & col. 6, l. 34-47, 60-63). The PDA communicates with the master computer and VCR through high power spread spectrum communications (col. 3, l. 60-61; col. 6, l. 1-17; & col. 10, l. 38-46). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the communication between the remote program access device and local interactive television program guide of Ellis et al. to include switching between a cellular network and a local spread spectrum network depending on a remote access device's location, such as that taught by Gaucher in order to provide a more cost-efficient device.

3. Claims 7, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. in view of Gaucher and further in view of Clapper.

Referring to claims 7 and 15, the combination of Ellis et al. and Gaucher teaches a program recording and playing apparatus/portable terminal according to claims 6 and 14, respectively. The combination of Ellis et al. and Gaucher does not teach that the short-distance wireless communication be based on the Bluetooth system. Clapper discloses controlling a set-top box with a remote control unit using a Bluetooth protocol (col. 2, l. 16-32). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the remote program access device in the combination of Ellis et al. and Gaucher to include

communicating with the set-top box over a Bluetooth protocol, such as that taught by Clapper in order to provide a simple and accessible protocol for communicating between devices.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968. The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH

  
CHRIS KELLEY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600